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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,477	09/10/2003	Gregory A. Piccionelli	39003.810US01	3434

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EXAMINER	
MOFIZ, APU M	
ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,477	PICCIONELLI ET AL.	
	Examiner	Art Unit	
	Apu M. Mofiz	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments submitted on 10/21/2006 with respect to claims 1-20 have been reconsidered but are not deemed persuasive for the reasons set forth below.

Examiner's Responses to Applicant's Remarks are listed below:

2. Sending and receiving email/communication is not a patentable subject matter (there are billions of prior art teaching the use of emails or other communication system). E-mail/mail is a medium to communicate someone's messages wishes to other person as the same way we talk/convey our thoughts to other person. Putting messages (video, audio or text) on a photograph (i.e., an image, now whether the image is of a celebrity or John Doe does not carry any patentable weight) is nothing new, and there are numerous prior arts that can be shown including Parker and the instant invention. Now sending someone an email/mail a message (to ask him or her to put a message/text on a picture) is nothing but an intended use of the e-mail/mail system. An intended use of prior art is not a patentable subject matter. A child was told by his/her mother to eat his/her lunch on time face to face. Now the same thing is done by e-mail or telephone system. Here sending email would be just a simple intended use of the email system or calling by phone would be a simple intended use of the telephone system. A mother almost never sends email to a child to remind him/her to eat his/her lunch, because a child (minor) usually does not have an email address.

Similarly a celebrities contact address is usually not known to the general public, therefore the public usually does not send any request to the celebrity. Therefore if a celebrity informs the general public of a system like that of Parker, where a message (audio, video or text) can be sent to the person (i.e., celebrity), the person can create a Personalized data file (e.g., a greeting card or a personalized celebrity photo or just a photo of a dog of the celebrity does not have any patentable difference) with the message provided to him with an image (whether the image is that of his/her own does not have any patentable weight). The celebrity or any other user, person can achieve the claimed invention by merely using the prior art of Parker.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Any other arguments by the applicant are more limiting or irrelevant than the claimed language.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker et al., (U.S. Patent Publication No. 2003/0004997 and hereinafter referred to as Parker).

As to claims 1, 13 and 18-20, Parker teaches a method of producing a personalized data file, the method comprising the steps of:

a) providing a message comprising at least one word to a person present at a site on a network and specifying a first data file, and (i.e., "These cards allow for the selection of a particular image, the selection or creation of a particular expression and also sometimes include audio or video files associated therewith as part of the presentation. ([0005]) ... means for a user to identify a particular expression and a particular image to thereby define a customized greeting card ... a delivery arrangement for delivering the printed greeting card to a recipient. ([0011]) ... It is also possible for the user to enter a chat room indicated at 470 to provide further customization and/or **suggestion by other users. In addition to being used by the greeting card sender in their personalized greeting cards, these expressions can also be submitted by the sender for inclusion in the entire expression database** ([0052]) ... At this point the user is preferably presented with a free form text creation process where the user can simply create their own expression without first selecting an expression from the database ([0055]) ... free lance photographers or graphic artists at 421 can provide uploaded electronic images for use by the sender in creating the greeting card ([0058]) ... It is possible to upload **a**

particular image for their own use in creating the card ([0059])" The preceding text excerpts clearly indicate that a person/a sender/a celebrity/a user can create his/her greeting cards by using a selected message from database (i.e., selecting a message, picture, image from the database by the use of a selection method e.g., a menu, list etc.) or **a message sent to him/her by others**. The user/celebrity can use his/her own image or any other image including images sent to him/her in creating the personalized greeting card. Therefore, any amount of personalization of the greeting card is possible. Applicant's argument that the image is not his/her own is not simply relevant to the determination of patentability. Any suggestion (i.e., instruction, message, images or any other files with any media that is possible (e.g., video, audio etc.) to be sent over any communication system (e.g., e-mail, IM etc.)) to create a personalized greeting card can be sent to the user (e.g., celebrity). Now, whether the user (i.e., the celebrity) creates the Personalized data file or his or wife/husband/friend does it for him/her is completely irrelevant/baseless argument. Parker system allows someone to send a message in any format e.g., video, audio, text etc., which can be selected by another person who creates a personalized greeting card. Parker system also allows the person (or persons e.g., celebrity, his/her spouse or children i.e., whether it is one person or multiple persons is not a patentable subject matter) who creates the personalized data file to edit/review that message and then store it in the database. Now if someone sends/suggests any message of sexually explicit nature e.g., a video file. Parker system allows another person to review the message and add that it is not suitable for most audience and store it in the database (i.e., record keeping). Any person (or persons) who receive(s) any suggestion with message (whether in a script i.e., in an instruction/dialog format, it is simply a message) naturally would review the message and if the message accompanies a

video file, he/she would naturally review/play the file. the Applicant's all arguments are null and void. Everything that the Applicant is claiming can be achieved/done by the Parker system. Who (i.e., whether the person is a celebrity or John Doe from the street corner) uses the Parker system, or what message (e.g., someone just sending a message stating how to play a video/audio file are simply messages) is sent using the system, how sexual are the messages are not patentable subject matter. Whether the person uses his/her own photograph or his/her pets photograph are not patentable subject matter. Finally Parker system allows digitally combining photo with audio/video/text to create a personalized data file. Parker system allows storing (for whatever reason e.g., record keeping or anything else; a specific reason is not patentable subject matter) originally received message/script/dialog, edited message/script/dialog (i.e., the reviewer can add his/her own experience with playing the video/audio file).

b) producing a personalized data file by digitally combining the first data file and the message, wherein the message is prepared by the person to whom the message was provided in step a) prior to being digitally combined with the first data file (See explanations above).

As to claim 2, Parker teaches wherein in step a) the message is provided to the person over a network (see explanations in rejected claim 1 above).

As to claim 3, Parker teaches wherein in step a) the first data file is specified by accessing a menu (see explanations in rejected claim 1 above).

As to claim 4, Parker teaches wherein in step a) the first data file comprises at least one image of the person (see explanations in rejected claim 1 above).

As to claim 5, Parker teaches wherein the first data file comprises a photographic image (see explanations in rejected claim 1 above).

As to claim 6, Parker teaches wherein in step b) the message is written by the person using a device which produces a data file corresponding to the message, and wherein the data file so produced is digitally overlaid on the photographic image (see explanations in rejected claim 1 above).

As to claim 7, Parker teaches wherein the first data file is a video file comprising a plurality of frames (see explanations in rejected claim 1 above).

As to claim 8, Parker teaches wherein in step b) the message is written by the person using a device which produces a data file corresponding to the message, and wherein the data file so produced is digitally overlaid on at least one of said plurality of frames (see explanations in rejected claim 1 above).

As to claim 9, Parker teaches wherein in step a) the first data file is a selected from the group consisting of a graphic file and a text file (see explanations in rejected claim 1 above).

As to claim 10, Parker teaches wherein in step a) the message comprises a script comprising dialog to be read by the person and the first data file is a video file (see explanations in rejected claim 1 above).

As to claim 11, Parker teaches wherein in step b) the dialog is read by the person and recorded to produce an audio file and wherein the audio file is digitally combined with the video file (see explanations in rejected claim 1 above).

As to claim 12, Parker teaches wherein the personalized data file is provided to a user over a network (see explanations in rejected claim 1 above).

As to claim 14, Parker teaches wherein in step a) the script is provided to a plurality of persons present at the site, and wherein in step b) the script is performed by the plurality of persons (see explanations in rejected claim 1 above).

As to claim 15, Parker teaches wherein the performance is subject to a record-keeping requirement and wherein information pertaining to the performance in accordance with the record keeping requirement is combined with the recorded performance (see explanations in rejected claim 1 above).

As to claim 16, Parker teaches wherein the recorded performance is provided to a viewer over a network (see explanations in rejected claim 1 above).

As to claim 17, Parker teaches wherein a premium is charged to a user providing the message in step a) (i.e., in Parker system a fee is charged for providing this greeting card service).

Conclusion

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

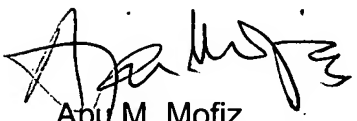
Points of Contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (571) 272-

4080. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached at (571) 272-4146. The fax numbers for the group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.



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